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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,616	07/24/2001	Vladimir Segal	30-5004 DIV3	6002

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EXAMINER

WILKINS III, HARRY D

ART UNIT	PAPER NUMBER
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1742

5

DATE MAILED: 08/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/912,616

Applicant(s)

SEGAL ET AL.

Examiner

Harry D Wilkins, III

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "strong" in claim 38 is a relative term that renders the claim indefinite. The term "strong" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The scope of the texture of the alloy is not defined by the claim.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claim 37 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lo et al (US 5,766,380).

Lo et al anticipate the claimed invention. Lo et al teach (see abstract) an alloy that has fine uniform grain sizes and a structure having a random orientation.

Regarding the process limitation of claim 37, the claim is a product-by-process claim and any art that discloses the same product anticipates the claim, even if made by a materially different process.

"Even though product - by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985)

6. Claim 38 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thornburg (US 3,849,212).

Thornburg anticipates the invention as claimed. Thornburg teaches (see col 11, lines 22-26) that the alloy has a "strong texture".

Regarding the process limitation of claim 38, the claim is a product-by-process claim and any art that discloses the same product anticipates the claim, even if made by a materially different process.

7. Claim 39 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Watanabe et al (US 3,653,981).

Watanabe et al anticipate the invention as claimed. Watanabe et al teach (see col 2, lines 54-62) that the alloy has a random texture.

Regarding the process limitation of claim 39, the claim is a product-by-process claim and any art that discloses the same product anticipates the claim, even if made by

a materially different process.

8. Claim 39 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Meeks, III et al (US 6,123,896).

Meeks, III et al anticipate the invention as claimed. Meeks, III et al teach (see abstract) that the alloy has a random texture.

Regarding the process limitation of claim 39, the claim is a product-by-process claim and any art that discloses the same product anticipates the claim, even if made by a materially different process.

9. Claim 39 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Zhang (US 6,193,821).

Zhang anticipates the invention as claimed. Zhang teaches (see col 2, lines 6-9) a Ta alloy that has a random texture.

Regarding the process limitation of claim 39, the claim is a product-by-process claim and any art that discloses the same product anticipates the claim, even if made by a materially different process.

10. Claim 39 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koike (JP 03-082773).

Koike anticipates the invention as claimed. Koike teaches (see English abstract) that the alloy has a random texture.

Regarding the process limitation of claim 39, the claim is a product-by-process claim and any art that discloses the same product anticipates the claim, even if made by a materially different process.

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11. Claim 39 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kawamata et al (JP 08-134606).

Kawamata et al anticipate the invention as claimed. Kawamata et al teach (see English abstract) that the alloy has a random texture.

Regarding the process limitation of claim 39, the claim is a product-by-process claim and any art that discloses the same product anticipates the claim, even if made by a materially different process.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry D Wilkins, III whose telephone number is 703-305-9927. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Harry D Wilkins, III  
Examiner  
Art Unit 1742

hdw  
August 7, 2002

ROY KING   
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700